



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: George A. Doherty, et al.

Serial No.: 10/501,176 Case 21014YP

Filed: July 12, 2004

For: SELECTIVE S1P1/EDG1 RECEPTOR AGONISTS

Art Unit:
1609

Examiner:
Jean-Louis, S. JM.

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

Sir:

This communication is in response to the restriction requirement dated August 22, 2007, setting forth a shortened statutory period for response ending September 22, 2007. Reconsideration of the restriction requirement and allowance of the above-captioned patent application are respectfully requested. This application relates to selective S1P1/Edg1 receptor agonists.

Claims 1 to 61 are currently pending in the application. The Examiner has required restriction of Claims 1 to 61, an election of one of **Group I to Group V** as outlined in the Restriction Requirement dated August 22, 2007 and an election of species. **Group I** is hereby elected with traverse. Applicants also hereby elect the specie of Example 77 (structure shown at page 21), the immunoregulatory abnormality of organ transplant rejection, the respiratory disease asthma and the combination therapy for a respiratory disease with a leukotriene antagonist, all with traverse.

Applicants respectfully request reconsideration of the restriction requirement with respect to Claims 1 to 61 and submit that these claims satisfy the unity of invention requirement because the groups are properly linked to form a single general inventive concept. As outlined in M.P.E.P. § 1893.03(d), a group of inventions is considered linked to form a single general

inventive concept when there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature. The expression "special technical feature" is defined as meaning those technical features that define the contribution which each claimed invention, considered as a whole, makes over the prior art.

Claims 1 to 61 are directed to a single general inventive concept under PCT Rule 13.1. Applicants respectfully disagree with the Examiner's characterization of the special technical feature at page 4. As stated at page 3 of the Specification, the invention relates to agonists of the S1P1/Edg1 receptor that possess a selectivity for the S1P1/Edg1 receptor over the S1P3/Edg3 receptor, which has advantages over current therapies and extends the therapeutic window of lymphocyte sequestration agents, allowing better tolerability with higher dosing and thus improving efficacy as monotherapy. Enhanced cardiovascular tolerability in rats is exemplified at page 162. Thus, there is a technical relationship among the claimed inventions, i.e., S1P1/S1P3 selectivity, that defines a contribution which each of the inventions, considered as a whole, makes over the prior art. As such, unity of invention is present and withdrawal of the restriction requirement is respectfully requested.

With respect to the election of species, Applicants have made this election to facilitate the Examiner's search with the understanding that the election requirement will be withdrawn upon the finding of an allowable generic claim. For the reasons stated above, Applicants disagree with the Examiner's statement at page 5, reading: "The species listed below do not relate to a single general inventive concept under PCT Rule 13.1, because, under PCT Rule 13.2, the species lack the same special technical feature among the different species."

Serial No.: 10/501,176
Case No.: 21014YP
Page 3

Based on the foregoing, Applicants respectfully request reconsideration and withdrawal of the requirement for restriction. Applicants submit that the application is in condition for allowance and passage thereto is earnestly requested. Any additional fees required in connection with this Response may be taken from Merck Deposit Account No. 13-2755. The Examiner is invited to contact the undersigned attorney at the telephone number provided below if such would advance the prosecution of the case.

Respectfully submitted,

By *Raynard Yuro*
Raynard Yuro
Reg. No. 45,570
Attorney for Applicants

MERCK & CO., Inc.
P.O. Box 2000
Rahway, New Jersey 07065-0907
(732) 594-0182

Date: September 19, 2007

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, on the date appearing below.

MERCK & CO., INC.

By *Larry Reynolds* Date 9.20.07